

II. REMARKS/ARGUMENTS

These Remarks are in reply to the Office Action mailed March 11, 2005.

Claims 1-4 and 10-15 were pending in the Application prior to the outstanding Office Action. The Office Action rejected claims 1-4 and 10-15. The present Reply responds to the rejections and demonstrates why all pending claims are patentable, leaving for the Examiner's consideration claims 1-4 and 10-15.

The Office Action rejected claims 1, 10, 12, 14, and 15 under 35 U.S.C. § 102(e) as being anticipated by *Zahavi et al.* (U.S. Patent No. 6,577,859; hereinafter, *Zahavi*). The Office Action rejected claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over *Zahavi*. The Office Action rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Zahavi*, and further in view of *Parikh et al.* (U.S. Patent No. 6,408,177; hereinafter, *Parikh*). The Office Action rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Zahavi*, and further in view of *Dowens et al.* (U.S. Patent No. 6,389,114; hereinafter, *Dowens*).

Specifically, contrary to the suggestion of the Office Action, and unlike Applicants' claim 1, *Zahavi* does not disclose a processing device for storing a conversation element. Instead, the cited section of *Zahavi* (col. 7, lines 33-45) discloses that the base station comprises the processing means for performing the steps described above (activation of a terminal function key by the user, causing a signal to be transmitted from the wireless terminal to a base station servicing the wireless terminal). The cited section of *Zahavi* further discloses that for instance, the base station has memory locations configured to store *standard system* messages and personalized messages *pre-recorded by a user*. . . . In no sense can standard system messages, which are by definition standardized and pre-determined regardless of individual user input, be equated with a conversation element, defined as text, graphics, audio or other multimedia clips or streams that are input by a user. Similarly, by no means can messages pre-recorded by a user, by definition *prior to the operation of Zahavi's* cellular phone system, be equated with a conversation element that is dynamically input in real-time by a user and then stored according to embodiments of the current invention. The contrast is clear between, on the one hand, real-time conversation, subject to unlimited modification and feedback based on dynamic developments, and, on the other hand, pre-recorded, standardized messages.

Moreover, contrary to the suggestion of the Office Action, and unlike Applicants' claim 1, *Zahavi* does not disclose a processing device for storing a conversation element associated with the

conversation representation. Instead, the cited excerpt from *Zahavi* (fig. 12) discloses a menu consisting of various menu items which the user can select as desired. This well-known aspect of cellular telephones, which *Zahavi* notes is "typical in the prior art, and [] is employed in one embodiment of the present invention," amounts to little more than a convenient interface allowing a user to select from among various pre-set, static options for operation of the cellular telephone. In no way can this well-known teaching, which *Zahavi* concedes is neither inventive ("typical in the prior art") nor an essential aspect of *Zahavi*'s cellular phone system ("employed in one embodiment"), be equated with the inventive disclosure of a processing device for storing a conversation element associated with the conversation representation.

Regarding independent claim 15, the Office Action comments (page 3, last paragraph) that this claim differs from claim 1 in that the second electronic device stores the conversation element and provides the conversation representation. Contrary to the suggestion of the Office Action, independent claim 15 also does not read on *Zahavi*. Specifically, unlike Applicants' claim 15, *Zahavi* does not disclose a second electronic device for storing a conversation element. By contrast, the cited section of *Zahavi* (col. 7, lines 20-33) discloses a wireless terminal comprising a processing chip, which has memory locations configured to store *standard system* messages and personalized messages *pre-recorded by a user*. Again, in no sense can standard system messages, which are by definition standardized and pre-determined regardless of individual user input, be equated with a conversation element, defined as text, graphics, audio or other multimedia clips or streams that are input by a user. Again, similarly, by no means can messages pre-recorded by a user, by definition *prior to the operation of Zahavi's* cellular phone system, be equated with a conversation element that is dynamically input in real-time by a user and then stored according to embodiments of the current invention. The contrast is clear between, on the one hand, real-time conversation, subject to unlimited modification and feedback based on dynamic developments, and, on the other hand, pre-recorded, standardized messages; this contrast illustrates the utility of the current invention relative to the prior art.

Moreover, contrary to the suggestion of the Office Action, and unlike Applicants' claim 1, *Zahavi* does not disclose a processing device for storing a conversation element associated with the conversation representation. Instead, the cited excerpt from *Zahavi* (fig. 12) discloses a menu consisting of various menu items which the user can select as desired. This well-known aspect of

cellular telephones, which *Zahavi* notes is "typical in the prior art, and [] is employed in one embodiment of the present invention," amounts to little more than a convenient interface allowing a user to select from among various pre-set, static options for operation of the cellular telephone. In no way can this well-known teaching, which *Zahavi* concedes is neither inventive ("typical in the prior art") nor an essential aspect of *Zahavi*'s cellular phone system ("employed in one embodiment"), be equated with the inventive disclosure of a processing device for storing a conversation element associated with the conversation representation.

The references cited in the Office Action, including *Zahavi*, *Parikh*, and *Dowens*, considered singly or in combination, fail to disclose all of the limitations of independent claims 1 and 15. Claims 2-4 and 10-14 each ultimately depend from independent claim 1 and are believed patentable for at least the same reasons as this independent claim and because of the additional limitations of these claims.

Accordingly, claims 1-4 and 10-15 are believed patentable over the cited references and withdrawal of the rejections is respectfully requested.

III. CONCLUSION

The references cited by the Examiner, but not relied upon, have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date:

7/11/05

By:

J. Steven Svoboda
J. Steven Svoboda
Reg. No. 44,366

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Fax: (415) 362-2928
Customer No.: 23910